



PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : D. Palm *et al.*
Serial No. : 09/936,545
Filed : November 14, 2001
For : MULTIPACK FOR REMOVING FILLED
BAGS IN A PREDETERMINED SEQUENCE
Examiner : Simon J. Oh
Art Unit : 1615
Confirmation No : 7110

745 Fifth Avenue
New York, New York 10151

I hereby certify that this correspondence is being deposited with
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Box 1450, Alexandria, VA 22313-1450, on August 4, 2003.

Mark W. Russell, Reg. No. 37,514

Name of Applicant, Assignee or Registered Representative



Signature

August 4, 2003

Date of Signature

**REQUEST FOR RECONSIDERATION FOR WITHDRAW OF FINAL REJECTION
AND/OR PETITION UNDER 37 CFR 1.181, AND AMENDMENT UNDER 37 CFR 1.116**

Mail Stop AF
Commissioner for Patents
Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Final Rejection mailed on May 20, 2003, Applicants request that the
Primary Examiner reconsider the propriety of the Final Rejection and withdraw it for being

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premature and/or the U.S. Patent Office treat this request as a Petition under 37 CFR 1.181,
should the Primary Examiner refuse to consider this request or deny withdrawing the Final
Rejection. Further, Applicants request that the following Amendment be entered and the remarks
considered.

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REQUEST FOR RECONSIDERATION AND/OR PETITION UNDER 37 CFR 1.181

Applicant respectfully request that the Primary Examiner reconsider the propriety of the final rejection and withdraw it as being premature so that the amendment to the claims may be entered as a matter of right. Alternatively, should this request be refused, then it is requested that the paper be treated as a petition and the Director is authorized to charge such fee, or credit any overpayment to Deposit Account 50-0320. Should the request and the petition be denied, then it is requested that the Amendment be entered as it does not add new matter that requires further consideration and/or search and it is urged that it places the application in condition for allowance or better condition for appeal.

In Paper No. 12, the Primary Examiner made the rejection final, alleging that the amendment to the claims necessitated the new ground of rejection, viz., the inclusion of Casper, U.S. Patent 5,422,119, in a rejection of the claims under 35 USC §103(a); this was the first time that Casper was relied upon in a rejection. Applicants respectfully urge that the inclusion of Casper in the rejection was not necessitated by the amendment as the claim element of “whereby the sequence of said bags correspond to the predetermined sequence of removal” had support in former independent claims 9 and 25. Hence, the inclusion of Casper in the rejection was not necessitated by amendment and the Final Rejection is premature.

The MPEP states that

[u]nder present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

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MPEP§706.07(a) (emphasis added). Thus, it is clear an applicant's amendment to the claims must necessitate the addition of a new reference in the rejection. In other words, merely because the claims were amended does not permit that an additional reference may be added to the rejection and the rejection then be made final; the amendment to the claims must necessitate the addition of the new reference.

The rejection relies upon Casper to teach the claim elements where the "individual bags are arranged in a predetermined sequence" and "whereby the sequence of said bags corresponds to the predetermined sequence of removal." In the second full paragraph on page 4 of the Office Action, the rejection states:

The Casper patent teaches methods of hormone replacement therapy and packages of pharmaceutical transdermal patches used to implement such methods. The package provides patches arranged in phases, each phase consisting of a transdermal estrogen substance alone, or a transdermal estrogen substance in combination with a transdermal progestin substance (See Abstract; and Column 5, Lines 27-48). It is further disclosed that the sequence of administration of the transdermal patches and their arrangement in a predetermined order is critical to the success of the invention (See Column 8, Lines 13-21). The patches may be also individually sealed in a protective pouch (See Column 9, Line 16-20). See also Claims 20-38.

(emphasis added). Thus, Casper is relied upon in the rejection to teach the arrangement of bags in a predetermined order. However, it is urged that removing the bags are arranged and removal according to a predetermined sequence have always been a claim element. For example, claim 19 concluded with the phrase "wherein the bags have different contents which are removed in a predetermined sequence" (emphasis added). Claim 25 stated that the bags "can be removed in a predetermined sequence." Hence, Applicants urge that the arrangement and removal of the bags was always an element of the claims and the reliance upon Casper in the rejection, was not

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necessitated by Applicants' amendment to the claims since this element was present in the claims before the rejection was issued.

In view of the foregoing, it is requested that the Primary Examiner reconsider the propriety of making the rejection final. Alternatively, should the Examiner deny this request, then it is requested that this paper be considered a petition so that the Commissioner can review the propriety of the Final Rejection. Finally, should all relief be denied then it is requested that this Amendment be considered under 37 CFR 1.116. Applicants urge that as the Amendment incorporates the claim element of claim 35 into claim 21, it does not require further consideration and/or search and places the claims in better condition for appeal or makes them allowable over the prior publication of record.